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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,955	08/27/2003	Bennett M. Richard	D5407-188	4065
25397	7590	03/07/2006	EXAMINER	
DUANE, MORRIS, LLP 3200 SOUTHWEST FREEWAY SUITE 3150 HOUSTON, TX 77027			COLLINS, GIOVANNA M	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 03/07/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/648,955
Filing Date: August 27, 2003
Appellant(s): RICHARD ET AL.

Gary R. Maze
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/15/05 appealing from the Office action
mailed 5/17/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,112,818	Campbell	9-2000
6,543,545	Chatterji et al.	8-2003
5,228,518	Wilson et al.	7-1993
2003/0047322	Maguire et al.	3-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Campbell 6,112,818.

Claims 1 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Chatterji et al. 6,543,545.

Claims 2-5,7-13 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chatterji et al. 6,543,545 in view of Wilson et al. 5,228,518..

(Note, in the Office action dated 5/15/05, the examiner inadvertently listed the rejected claims as claim 1-5,7-13 and 18-20. However, the correct listing should be claims 2-5,7-13 and 18-20).

Claims 1,2,4,6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maguire et al. 2003/00447322.

(10) Response to Argument

Note, the applicant failed to put headings in the argument section. However, this is considered a minor error and the arguments are clearly understood, therefore an Examiner's answer has been written.

Regarding to Campbell reference, the applicant argues the centralizer (fig. 1, at 17) disclosed by Campbell does not position the tubular after delivery. First the term delivery is very broad. The applicant only states in claim 1, the tubular is delivered into the borehole. The applicant never states when the delivery step ends. As broadly claimed, the delivery step could end when the first section (at 16) of the tubular actually enters into the borehole and then the positioning step begins when the centralizers (17) enter the well. Even if the delivery step ends when the end of the tubular reaches the bottom of the borehole (20), the centralizer (17) will still position the tubular in the wellbore after the tubular has be delivered to the bottom of the borehole (at 20). The applicant argues the centralizers stick out and are prone to snag and their operation is not entirely reliable and they impede the expansion of the tubular that they surround. These arguments do not negate the fact the centralizer will still position the tubular after the tubular has been delivered (col. 2, lines 27-45) and the tubular is expanded (col. 3, lines 14-21). The applicant is incorrect in the statement the examiner contends the reference shows positioning only after it delivered. The claims do not recite the recite

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the positioning cannot occur during delivery only that after delivery a positioning step occurs. In the Campbell reference, after the tubular is delivered to the bottom of the borehole the centralizers (48) will position the tubular in the well. The applicant also argues that the centralizers cannot position a tubular that is delivered into a deviated well bore. However, this argument is moot since the claims do not recite the tubular is delivered to a deviated wellbore.

Regarding the Chatterji reference, the applicant argues the centralizers (see fig. 1, at 48) operate only during "run-in" and do not position the tubular after delivery. As stated above the term delivery is broad and the applicant does not indicate in the claims when the delivery step ends and the positioning step begins. The delivery step could begin when the first section of the tubular (fig. 1, at 68) is actually installed in the well and the positioning step could begin when the centralizers (at 48) first enter the well. Even if the delivery step ends when the end of the tubular reaches the bottom of the borehole, the centralizer (48) will still position the tubular in the wellbore after the tubular has be delivered to the bottom of the borehole.

Referring to combination of the Chatterji and Wilson references, the applicant argues the Wilson reference is concerned with delivering cement and not with tubular expansion and the Chatterji reference is concerned with tubular expansion on a tubular having a centralizers. The applicant further states that there is no reason to combining the two references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the

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claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Chatterji teaches bow spring like centralizers that used to position a tubular when delivered to a wellbore. Wilson teaches (fig. 2) a type of centralizers that are extendable members (80) in an opening on a tubular (60). Wilson teaches bow spring like centralizers have a possibility to be damaged during run in (col. 1, lines 39-45) and centralizers that members that extend in an opening on a tubular will not be damaged during installation because the centralizers are located internally until ready extended to position the tubular (col. 1, line 67-col. 2, lines 9). The combination involves changing one type of centralizer for another type of centralizer to help minimize any damage to the centralizers that could happen to the centralizers during run in. As it would be advantageous to minimize damage to the damage to the centralizers so the will last longer, it would be obvious to one ordinary skill in the art at the time of the invention to modify the centralizers disclosed by Chatterji to use the extendible centralizers in view of the teachings of Wilson.

Referring to the arguments concerning the Maguire reference, the applicant argues there is no need to position the tubular. However, if the tubular (See fig. 4, at 200) is sitting in a cocked position when delivered into the wellbore, the tubular (200) would have to be positioned in order to easily install the expansion equipment (100) into the tubular. As it would be advantageous to reposition the tubular so the expansion

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easily installed in the tubular, it would be obvious to one of ordinary skill in the art to modify the method disclosed by Maguire to position a tubular after deliver into a wellbore.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Giovanna M. Collins

Conferees:

djb



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